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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,340	05/15/2001	Thomas J. Hosted JR.	IN01164K	9296

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

SCHLAPKOHL, WALTER

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/855,340	Applicant(s) HOSTED ET AL.	
	Examiner Walter Schlapkohl	Art Unit 1636	<i>WJF</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-18,21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8-18,21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of the papers filed on 9/29/2005.
Claims 1, 6, 8-18, 21 and 24-26 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 U.S.C. §102

Claims 1, 6, 8-18, 21 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hosted et al (US2004/0101832 A1; see the entire application) or Hosted et al (U.S. Patent No. 6,861,513 B2; see the entire reference). This rejection is maintained for reasons of record in the office action mailed 5/6/2005, which grounds for rejection are repeated below.

The applied reference has a common assignee and common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 USC 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus

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not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

U.S. Patent 6,861,513 and U.S. 2004/0101832 are derived from the same application (Serial No. 09/758,759). All of the citations presented below are taken from the published application.

Hosted et al teach nucleic acids and vectors encoding an *M. carbonacea*-specific integrase gene and the cognate integration site (e.g. Figures 9A & 9B; paragraphs 0028, 0033, 0151; SEQ ID NO:176). Thus, Hosted et al teach nucleic acids, vectors and host cells that meet the claim limitations.

Response to Arguments

Applicant argues that the rejection of claims 1, 6, 8-18, 21 and 24-26 under 35 U.S.C. §102(e) should be withdrawn because Hosted et al is not a prior art reference with respect to the instant application because the *Xis* gene sequence (SEQ ID NO:2) and the *M. carbonacea* attP/attB region (SEQ ID NO:6) were discovered before the 12 January 2000 priority date of the cited references. As evidence of this point Applicant has submitted a declaration under 37 CFR § 1.131 ("Hosted Declaration").

Applicant's arguments are respectfully found unpersuasive for the reasons set forth below.

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Response to Amendment

The declaration filed on 9/29/2005 under 37 CFR 1.131 has been considered but is ineffective. An affidavit or declaration under 37 CFR 1.131 may be accepted by all the inventors of the subject matter claimed or by less than all the named inventors of an application where it is shown that less than all the named inventors of an application invented the subject matter of the claim or claims under rejection (see MPEP 715.04). Since the declaration seeks to overcome rejection of all remaining claims and since it has not been shown that less than all the named inventors of the instant application invented the subject matter of the claims under rejection, the declaration filed is ineffective.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Certain papers related to this application may be submitted to the Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is (571) 273-8300. Note: If Applicant does submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent applications to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at (800) 786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Walter A. Schlapkohl whose telephone number is

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(571) 272-4439. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office.)

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.

Walter A. Schlapkohl, Ph.D.
Patent Examiner
Art Unit 1636

November 4, 2005



JAMES KETTER
PRIMARY EXAMINER